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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,424	05/09/2001	Yuji Tsukamoto	040447-0233	2129
22428	7590	06/14/2006	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/851,424	TSUKAMOTO ET AL	
	Examiner	Art Unit	
	FIRMN BACKER	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant disclosed a system "wherein the record medium comprises a controlling portion controlling at least one of the recording or the reproducing of the content through at least one of the methods of confirming an encryption code or checking whether a predetermine time has elapsed." This limitation is not described in the specification and is considered to be new matter.
4. The amendment filed March 30th 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall

introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant disclosed a system “wherein the record medium comprises a controlling portion controlling at least one of the recording or the reproducing of the content through at least one of the methods of confirming an encryption code or checking whether a predetermine time has elapsed.”

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Allen (U.S. Patent No. 5,909,638) in view of Phillipino et al (U.S. PG Pub No. 20050246284 A1)

7. As per claim 1, Allen teaches a contents rental system (*video kiosk, 123a-n*) comprising a content producer (*archive data, 1805*) for producing a content, a rental business server (*point of sale or rental retail transaction engine, 121*), disposed in a store (*retail outlet, fig 17-20*) managed by a rental business operator, for recording the content produced by the content producer and downloading the contents to a record medium (*vhs*) corresponding to a command

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issued by a customer, and a reproducing device, disposed in a house of the customer, for reproducing the contents from the record medium (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43*). Allen fail to teach a system wherein the record medium comprises a controlling portion controlling at least one of the recording or the reproducing of the content through at least one of the methods of confirming an encryption code or checking whether a predetermined time has elapsed. However, Phillipop et al teach a system wherein the record medium comprises a controlling portion controlling at least one of the recording or the reproducing of the content through at least one of the methods of confirming an encryption code or checking whether a predetermined time has elapsed (*see paragraphs 0015, 002, claims 19-21*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Allen's rental system to include Phillipop et al's system wherein the record medium comprises a controlling portion controlling at least one of the recording or the reproducing of the content through at least one of the methods of confirming an encryption code or checking whether a predetermined time has elapsed because this would have discourage illicit copying from a digital record carrier to a computer-readable data storage device.

8. As per claim 2, Allen teaches a contents rental system wherein the rental business operator records an advertisement picture to the record medium along with the content such advertisement picture is reproduced by the reproducing device dispose on the premise of the customer (*see fig 1, col. 21 lines 10-25*).

9. As per claim 3, Allen teaches a contents rental system wherein when an icon contained in the advertisement picture is clicked when the advertisement picture is reproduced by the reproducing device disposed on the premise of the customer, the reproducing device is connected to an advertisement server through the Internet (*see fig 1, col. 21 lines 10-25*).

10. As per claim 4, Allen teaches a contents rental system wherein the record medium comprises: a content storing portion for storing the content encrypted, a memory for storing a decryption key for decrypting the content encrypted; and a capacitor for backing up the memory, wherein the capacitor is charged by the rental business server (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43*).

11. As per claim 5, Allen teaches a contents rental system wherein the record medium comprises: a content storing portion for storing the content; a memory for storing a control algorithm for reading the content; and a capacitor for backing up the memory, wherein the capacitor is charged by the rental business server (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43*).

12. As per claim 6, Allen teaches a contents rental system wherein the record medium comprises: a content storing portion for storing the content encrypted; a memory for storing a decryption key for decrypting the content; and a timer for causing the decryption key stored in

the memory to be erased when a predetermined time period elapses after the record medium is connected to the rental business server (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43*).

13. As per claim 7, Allen teaches a contents rental system wherein the record medium comprises: a content storing portion for storing the content; a memory for storing a control algorithm for reading the content; and a timer for causing the control algorithm stored in the memory to be erased when a predetermined time period elapses after the record medium is connected to the rental business (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43*).

14. As per claim 8, Allen teaches a contents rental system comprising: a capacitor, charged by the rental business server, for supplying a power to the timer (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43*).

15. Claims 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Patent No. 5,909,638) in view of Candelore (U.S. PG Pub No. 2004/0151314).

16. As per claim 9, Allen teaches a contents rental system for downloading a content to a record medium of a customer comprising: a content producer for producing the content; a management center for delivering the content produced by the content producer to a plurality of

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rental business operators; a rental business server, disposed in a store managed by each of the rental business operators, for recording the content delivered from the management center, downloading the recorded content to the record medium corresponding to a command issued by the customer and a reproducing device, disposed in a house of the customer for restoring the content from the record medium (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43*). Allen fails to teach or suggest a system wherein the content on the record medium is encrypted based on data stored on the IC card electrically connected to the rental business server and wherein the reproducing device decrypts the content using the data on the same IC card electrically connected to the reproducing device. However, Candelore teaches and suggest a system wherein the content on the record medium is encrypted based on data stored on the IC card electrically connected to the rental business server and wherein the reproducing device decrypts the content using the data on the same IC card electrically connected to the reproducing device (*see fig 2, paragraphs 0034-0041*). Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to modify Allen's system to include Candelore's system wherein the content on the record medium is encrypted based on data stored on the IC card electrically connected to the rental business server and wherein the reproducing device decrypts the content using the data on the same IC card electrically connected to the reproducing device because this would have enhance the security of the system.

17. As per claim 10, Candelore teaches a contents rental system wherein when the IC card is set to the reproducing device, the reproducing device authenticates the IC card and the IC card authenticates the reproducing device (*see fig 2, paragraphs 0034-0041*).

18. As per claim 11, Candelore teaches a contents rental system wherein the reproducing device is authenticated by a process in which the reproducing device transmits a reproducing device public key certificate to the IC card and the IC card authenticates the reproducing device public key certificate, and wherein the IC card is authenticated by a process in which the IC card transmits an IC card public key certificate to the reproducing device and the reproducing device authenticates the IC card public key certificate (*see fig 2, paragraphs 0034-0041*)

19. As per claim 12, Candelore teaches a contents rental system wherein the reproducing device is authenticated in such a manner that the IC card encrypts a random number using a reproducing device public key and transmits the encrypted random number to the reproducing device, that the reproducing device decrypts the encrypted random number using a reproducing device secret key and transmits the decrypted random number to the IC card, and that the IC card authenticates the reproducing device using the decrypted random number (*see fig 2, paragraphs 0034-0041*)

20. As per claim 13, Candelore teaches a contents rental system wherein the IC card is authenticated in such a manner that the reproducing device encrypts a random number using an IC card public key and transmits the encrypted random number to the IC card, that the IC card

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decrypts the encrypted random number using an IC card secret key and transmits the decrypted random number to the reproducing device, and that the reproducing device authenticates the IC card using the decrypted random number (see fig 2, paragraphs 0034-0041)

21. As per claim 14, Candelore teaches a contents rental system wherein when the IC card is set to the rental business server, the rental business server authenticates the IC card in cooperation with the management center (see fig 2, paragraphs 0034-0041)

22. As per claim 15, Candelore teaches a contents rental system wherein the IC card is authenticated by a process in which the IC card transmits an IC card public key certificate to the management center through the rental business server and the management center authenticates the IC card public key certificate (see fig 2, paragraphs 0034-0041)

23. As per claim 16, Candelore teaches a contents rental system wherein the IC card is authenticated in such a manner that the management center encrypts a random number using an IC card public key and transmits the encrypted random number to the IC card through the rental business server, that the IC card decrypts the encrypted random number using an IC card secret key and transmits the decrypted random number to the management center through the rental business server, and that the management center authenticates the IC card using the decrypted random number (see fig 2, paragraphs 0034-0041)

24. As per claim 17, Candelore teaches a contents rental system wherein when the IC card is set to the rental business server, the IC card transmits a reproducing device public key certificate to the management center through the rental business server and the management center authenticates the reproducing device corresponding to the reproducing device public key certificate (see fig 2, paragraphs 0034-0041)

25. As per claim 18, Candelore teaches a contents rental system wherein when the record medium and the IC card are set to the rental business server and the customer selects a content, the rental business server transmits contract information to the IC card, the IC card encrypts the contract information and transmits the encrypted contract information to the management center through the rental business server, after the management center decrypts the encrypted contract information and authenticates the contract information, the management center encrypts an encryption key of the content selected by the customer and transmits the encrypted content to the IC card through the rental business server, after the IC card decrypts the encrypted content encryption key and authenticates the content, the IC card transmits a normal completion message to the rental business server, and the rental business server receives the normal completion message and downloads the content to the record medium (see fig 2, paragraphs 0034-0041)

26. As per claim 19, Candelore teaches a contents rental system wherein when the record medium and the IC card are set to the reproducing device, the reproducing device transmits a content encryption key transmission request to the IC card, the IC card receives the transmission request, encrypts a content encryption key, and transmits the encrypted content encryption key to

the reproducing device, and after the reproducing device decrypts the encrypted content encryption key and authenticates the decrypted content encryption key, the reproducing device reproduces the content using the decrypted content encryption key (see fig 2, paragraphs 0034-0041).

Response to Arguments

27. Applicant's arguments filed March 30th, 2006 have been fully considered but they are not persuasive.

a. Applicant amend the claim 9 and argues that the prior art taken alone or in combination fail to teach a system wherein the content on the record medium is encrypted based on data stored on the IC card electrically connected to the rental business server and wherein the reproducing device decrypts the content using the data on the same IC card electrically connected to the reproducing device. Examiner respectfully disagrees with Applicant characterization of the prior art. Candelore teaches among other things a Smart card interface 420 receives a smart card including encrypted control words for descrambling scrambled program content. Smart card 410 may transmit the control words in encrypted form to the smart card interface 420. If the content was originally scrambled using control words in addition to keys, the smart card 410 may use an encryption control key unique to unit 401 to encrypt the control words. The conditional access unit 401 will decrypt the control words and use the clear control words to descramble the program content.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

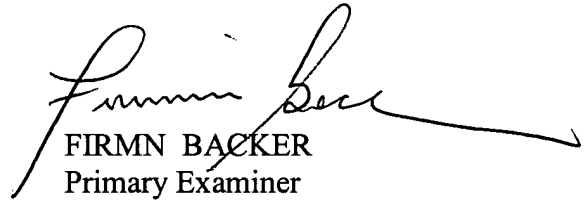
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMIN BACKER whose telephone number is 571-272-6703. The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



FIRMIN BACKER
Primary Examiner
Art Unit 3621

June 6, 2006